Image 1647

PATENT
New Attorney Docket No. 544582000200
Old Attorney Docket No. 38596.0005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Anton Wellstein)
)
Appl. No.: 09/880,097)
) Examiner: Christopher J. Nichols
Filing Date: June 14, 2001)

Group Art Unit: 1647

Title: PLEIOTROPHIN GROWTH FACTOR RECEPTOR FOR THE TREATMENT OF PROLIFERATIVE, VASCULAR AND NEUROLOGICAL DISORDERS

REQUEST FOR FIVE MONTH EXTENSION OF TIME AND RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

REQUEST FOR FIVE MONTH EXTENSION OF TIME

Applicant respectfully requests a five-month extension of time to respond to the Office Action, mail dated August 19, 2003, (Paper No. 5), to extend the period of time for filing this response up to and including February 19, 2004. **Please charge the requisite five-month, small entity extension fee of $1,005 to Deposit Account No. 03-1952.**

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a.) Introductory Comments:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action, mail dated August 19, 2003 (Paper No. 5), applicant respectfully makes the following provisional election and requests reconsideration of the Restriction in view of applicant's remarks below.

Applicant provisionally elects Group II, claims 10-17 and 21-23, with traverse.

d.) **Remarks**

In the Office Action, restriction is deemed required, under 35 US.C. §121, to one of the following groups of claims:

Group I: Claims 1-9, drawn to isolated polypeptide complex comprising a pleiotrophin protein and a pleiotrophin-receptor protein (class 530, subclass 350);

Group II: Claims 10-17 and 21-23, drawn to a recombinant polypeptide comprising one or more, but not all regions of a full-length pleiotrophin receptor protein and compositions comprising same (class 530, subclass 300);

Group III: Claims 18-20, drawn to a nucleic acid which encodes the polypeptide of claim 10 (class 514, subclass 23.1);

Group IV: Claims 24, 25, 29 and 30, drawn to a recombinant polypeptide comprising one or more, but not all regions of a full-length pleiotrophin protein and compositions comprising same (class 530, subclass 300);

Group V: Claims 26-28, drawn to a nucleic acid which encodes the polypeptide of claim 24 (class 514, subclass 23.1);

Group VI: Claims 31-36, drawn to an antibody which is reactive against a pleiotrophin protein and hybridoma comprising same (class 435, subclass 326);

Group VII: Claims 37-46, drawn to an antibody which is reactive against a pleiotrophin-receptor protein and hybridoma comprising same (class 435, subclass 326);

Group VIII: Claims 47-49, drawn to a kit comprising a pleiotrophin-binding region of a pleiotrophin-receptor binding region of a pleiotrophin protein and an additional substance (class 436, subclass 500);

Group IX: Claims 50-59, drawn to a method for evaluating an activity of a substance (class 514, subclass 2); and

Group X: Claims 60-68, drawn to a method for treating a patient comprising administering to said patient a therapeutically effective dose of a composition comprising a pleiotrophin-receptor protein or fragment thereof (class 514, subclass 2).

As recited under M.P.E.P. 803, restriction is appropriate only when the groups can be shown to be distinct and there would be a **"serious burden"** placed on the Examiner to examine more than one group of claims. No such serious burden has been established and applicant respectfully requests that this restriction be withdrawn.

In the instant application, all of the claims are directed to tools and methods involving the interaction between pleiotrophin and the pleiotrophin receptor. As such, a search of all claims would amount to a search of the same subject area and, thus, it should not be considered a serious burden on the examiner to examine all of the claims together. It is respectfully requested that this requirement be withdrawn. Applicant further offers the following remarks.

First, and as stated above, there are two basic criteria for applying a restriction requirement. The invention must fall into one or more of the standards set forth in the Manual of Patent Examining Procedure ("MPEP"), and there must be a serious burden placed on the examiner to examine all claims together. The comments in Paper No. 5 with respect to the restriction relate only to the first criteria, application of the rules of the MPEP to this case. No comments are made with respect to the second criteria, why it would be a serious search burden. The burden to show the appropriateness of this restriction rests with the U.S. Patent and Trademark Office ("PTO"). As that burden has not been met, applicant respectfully requests that this restriction requirement be withdrawn.

Second, in reviewing the classification structure imposed, it appears that the groups fall into mostly the same or very closely related search groups. For example, most claim groups (Groups I, II, and IV) fall into one class, namely, class 530. Other groups fall into closely related

classes 514 (Groups III, V, IX and X) and 435 (Groups VI and VII). Thus, examination of only these three classes would cover nearly all of the claims. Further, the claims for each group fall into the same or very similar subclasses (Class 530 = subclasses 300 and 350; Class 514 = subclasses 2 and 23.1; Class 435 = subclass 326). In view of the search structure alone, it is clear that examination of all claim groups would not impose a serious examination burden.

As stated above, a restriction requirement is imposed "only" when it would be a serious burden on the examiner to examine all of the claims at once. As a serious burden is not imposed by an examination of all claims, withdrawal of the restriction and examination of all claim groups is respectfully requested.

Alternatively, if a complete withdrawal is not granted, applicant respectfully requests that the restriction be re-evaluated and that Groups I, II and IV be combined and examined together.

Conclusion

The application is in condition for examination and the prompt issuance of an Office Action is respectfully requested. If there are any additional fees due with the filing of this Response, including any additional fees for a further extension of time, not herein accounted for, applicant respectfully requests that extension and also requests that any and all fees due be charged to Deposit Account No. 03-1952.

Respectfully submitted,
Morrison & Foerster LLP

Date: February 2, 2004

By _____
James Remenick
Registration No. 36,902

Morrison & Foerster LLP
1650 Tyson's Blvd., Suite 300
McLean, VA 22102
(703) 760-7700 (telephone)
(703) 760-7777 (telecopier)